REMARKS

The following remarks and the above amendments are submitted to address all issues in this case, and to put this case in condition for allowance. Applicant amends the claims in this case to cancel claims which currently stand rejected in light of references other than Mao (US 6,279,706) and to place certain dependent claims in independent form to simplify issues on Appeal; no new matter is added in these amendments. After the above amendments, claims 2-9, 12, 13, and 18-22 are pending in the application. Claims 7, 12, 18, and 21 are independent.

Applicant has studied the Office Action Mailed March 24, 2004, and has the following remarks.

35 U.S.C. §§ 102/103

Liang, Zwanzig, Gelb, JP329 and JP '929

Claims 16, 17, and 23 stood rejected in light of one or more of the above references. Applicant has cancelled these claims for the sole purpose of simplifying issues presented on Appeal to those only involving Mao. Applicant in no way admits that the rejection is proper and reserves all rights to pursue claims to subject matter within the scope of claims 16, 17, and 23 in the Divisional Application claiming priority to this Application and co-filed herewith.

Mao

The Examiner rejected prosecution claims 2-9, 12-13, and 16-23 based on 35 U.S.C. §102(e) as anticipated by Mao (United States Patent No. 6,279,706).

Applicant previously submitted a Declaration of Prior Invention in accordance with 37 C.F.R. § 1.131 ("Rule 131") as a means to testify to a date of actual reduction to practice for the present invention that is earlier than the effective date of the Mao reference.

Applicant respectfully notes that the examiner has presently rejected the pending claims under 35 USC §102(e) which is a rejection which may be overcome by the submission of a Rule 131 declaration so long as the claims are not directed to the "same patentable invention" as the reference (See MPEP §715).

If the claims were considered by the Examiner as directed to the "same patentable invention," they should stand rejected under 35 USC §101 (as the cases are co-owned). The Examiner has not issued this rejection, however, which indicates that the claims have not been rejected as directed to the same patentable invention. If the Examiner intended to issue a §101 rejection instead of the current §102(e) rejection, Applicant respectfully requests a telephone call to the below signed attorney of record so that the resolution of that issue may be promptly resolved by a filing responsive to such a rejection.

With regards to a 35 USC §102(e) rejection where the claims are not directed to the "same patentable invention" as the reference, Rule 131 states that a reference can be antedated by providing a suitable declaration in which the "showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence. . . ." 37 CFR § 1.131(b) (emphasis added).

The Examiner stated in the March 24, 2004 Office Action "The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Mao reference to either a constructive reduction to practice or an actual reduction to practice. In fact, there is no evidence from a date prior to the date of reduction to practice prior to the filing date of the Mao reference." (Page 3, emphasis added)

Applicant respectfully notes that in this case diligence does not need to be shown as the declaration shows actual reduction to practice prior to the effective date of the cited reference.

The Declaration clearly shows a prototype backpack actually reduced to practice at a time prior to the effective date of the Mao reference. The Declaration includes evidence of the actual reduction to practice of an embodiment of the invention in the form of photographs of the actual device, as well as statements by the inventor of conception and, in addition, statements of the recognition of the physical embodiment's usefulness in solving a problem and when that occurred. There is no question that the Rule 131 Declaration previously submitted sufficiently shows actual reduction to practice of an embodiment of the invention, and that the Rule 131 Declaration previously submitted need not show diligence, because under Rule 131 diligence is not an issue when an actual reduction to practice has been shown to have occurred prior to the effective date of the reference cited by the examiner.

Applicant therefore again asserts that the Rule 131 Declaration previously submitted is sufficient to demonstrate the invention was actually reduced to practice prior to the effective date of Mao. That being shown, Mao is removed as a § 102(e) reference. Therefore, the claims pending after the above amendment are believed allowable over the cited art.

Applicant respectfully requests the Examiner's rejection of the pending claims be withdrawn and that this case be allowed to continue to issuance without need for Appeal.

Conclusion

In light of the above, Applicant respectfully requests entrance of the above amendment and allowance of all pending claims so that this case can pass on to issue. In the alternative, Applicant requests entrance of the above amendment to simplify issues for purposes of Appeal.

As a final point, there is also included herewith a Notice of Appeal and the associated Appeal fee. It is believed no other fees are due in conjunction with this filing; however, the Commissioner is authorized to credit any overpayment or charge any deficiencies necessary for

entering this amendment, including any claims fees and/or extension fees to/from our **Deposit Account No. 50-0975.**

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If any questions remain, Applicant respectfully requests a telephone call to the below-signed attorney at (314) 444-7783.

Respectfully submitted,
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